

REMARKS

Claims 24, 26, 27, and 40-70 are pending. By this response no claims are canceled, amended, or added. No new subject matter is introduced.

Applicant acknowledges that the Examiner has expressly withdrawn all previous rejections made under 35 U.S.C. §§ 102 and 103.

Claim Rejections under 35 U.S.C. § 103

The Examiner indicated that claims 24, 26, 27, and 40-70 are newly rejected under 35 U.S.C. § 103 as being unpatentable over Chu et al. in view of any of a variety of references which were previously cited in combination with the Davis reference, the latter now acknowledged by the Examiner not to form part of the prior art for the purpose it was cited. For reasons stated below, Applicant respectfully disagrees and requests the Examiner to reconsider and withdraw the rejection under 35 U.S.C. § 103.

Applicant respectfully reminds the Examiner that the present application claims benefit of EP application no. 97101019.4, having a filing date of January 23, 1997. The Chu et al. reference cited by the Examiner has a publication date of November 17, 1997. Thus the reference of Chu et al. post-dates the claimed priority date by nearly ten months.

In citing Chu et al., the Examiner acknowledged on page 4 of the Office Action that Chu et al. do not teach the particular polynucleotide sequences claimed, nor the incorporation of phosphorothioate internucleotide linkages into oligonucleotides. The Examiner then went on to combine Chu et al. with various references alleged to teach, inter alia, particular claimed polynucleotide sequences and the incorporation of phosphorothioate internucleotide linkages into oligonucleotides.

Review of the priority document for the instant application, however, reveals that all of the claimed sequences and the incorporation of phosphorothioate internucleotide linkages into


oligonucleotides are disclosed therein. More specifically, the Examiner is referred to Table 4 on page 9 of the priority document, where are specifically disclosed the sequences corresponding to instantly claimed SEQ ID NOs 8-14, 16, 17, and 19-23. In addition, the Examiner is referred to page 4, lines 29-31, as well as claim 8 of the priority document for disclosure there of the incorporation of phosphorothioate internucleotide linkages into oligonucleotides.

In view of the foregoing, Applicant respectfully submits that Chu et al. is not effective as a prior art reference against the instant application, and, accordingly, Chu et al. cannot be combined with any of the references as suggested by the Examiner. It is respectfully submitted, therefore, that the Examiner has not made a prima facie case for making an obviousness rejection. Accordingly, Applicant respectfully requests the Examiner to reconsider and withdraw the rejection of claims 24, 26, 27, and 40-70 under 35 U.S.C. § 103.

Summary

Applicant believes the application is in condition for allowance. A Notice of Allowance is earnestly solicited. Should the Examiner have any questions, she is requested to call Applicant's representative at the number shown below.

Respectfully submitted,
Wagner et al., Applicant

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